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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,757	10/13/2000	Chul-woo Lee	030681-032	8067

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EXAMINER

STAFIRA, MICHAEL PATRICK

ART UNIT PAPER NUMBER

2877

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/689,757

Applicant(s)

LEE ET AL.

Examiner

Michael P. Stafira

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/640,474.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Reissue Applications

After further review Examiner found defects in the Reissue applicant and therefore prosecution of the claims is reopened.

Oath/Declaration

1. The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414.

The declaration is defective because it fails to state an error relied upon for reissue. The statement that "The issued claims less than patentee has the right to claim in reciting the light blocking aspect of the second region in each of the claims rather than the positive aspect of the first region." fails to satisfy the requirement of 37 CFR 1.175(a)(1) because it does not state or specify an error that supports the reissue. 37 CFR 1.175(a)(1) and MPEP 1414, II. The alleged error of "the light blocking aspect of the second region" is not found in the patent claims.

2. Claims 1-40 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

35 U.S.C. 251 Rejection

3. Claims 27-40 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

A review of the prosecution of application No. 08/640,474, which matured into US Patent No. 5,822,135, reveals that, in response to the Office rejection of claims 1-3,11,13-15,17-19 and 23 under 35 USC 102(e) as being anticipated by Okamoto (US patent 5,502,001) of June 24, 1997, applicant amended claim 1 by adding to the recitation "said light controlling means permitting light in said near and far regions of said light path to reach said focal zone" the limitation "**without imposing a relative phase change between light in said near and far regions**" and argues that "As expressly disclosed throughout the application, the present invention is a lens device including a lens for focusing light into a focal zone and having a predetermine effect diameter. The lens device includes a light controlling means provided in the light path of the lens for preventing light in an intermediate axial region of the light path from reaching the focal zone ... A light controlling means permits light and the near and far regions of the light path to reach the focal zone **without phase shift relative to one another**. (Emphasis original) See Response filed 10/14/97, paragraph bridging pages 6 and 7. It is further stated on page 7, 2nd full paragraph, that "Applicant has discovered a mechanism wherein the phase-shifting technology is not necessary to the operation, which leads to a simpler design and reduce overall expense conforming the lens device." For this reason, applicant urged that the rejection

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based on 35 USC 102(e) be withdrawn since the combination of the features found in the claims are not anticipated by the Okamoto patent.

A review of the newly submitted claims 27-40 reveals that none of the independent claims 27,30,32 and 37 recites a light controlling means that permits light in the near and the far regions of the light path to reach the focal zone **without imposing a relative phase change of shift between the light in the near and far regions** as set forth in patent claim 1, the only independent claim in the patent. Thus, the newly presented independent claims 27,30,32 and 37 are broader than the patent claim 1 in the aspect of not having phase change or shift between the light in the near and far regions.

It is clear from the prosecution record of the patent that claim 1 was amended by adding the limitations "without imposing a relative phase change..." to overcome the rejection of claim 1 under 35 USC 102(e) over the Okamoto patent. Furthermore, it is argued that the prior art required a phase shift while, in applicants invention, the phase shifting technology was not necessary. By amending the claims to exclude the phase change/shift and arguing that such feature defined applicant's invention has been surrendered to the public. Thus, by not including the recitation of the controlling means that permits light to reach the focal zone without imposing a relative phase change between the light in the near and far region in new independent claims 27,30,32, and 37, applicant is attempting to recapture subject matter that has been surrendered during the original prosecution of the patent.

From the above analysis, the applicant has specifically limited the claim to exclude phase changing of the light to obtain the patent. On reissue, applicant is stopped from attempting to recapture this precise feature that is added and argued to overcome the prior art rejection over the

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Okamoto patent. Therefore a case of recapture is made for claims 27-40 under 35 USC 251 which applicant must address before the reissue application may be allowed.

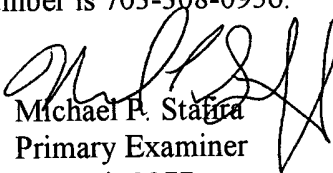
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Stafira whose telephone number is 703-308-4837.

The examiner can normally be reached on 4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 703-308-4881. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Michael P. Stafira
Primary Examiner
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November 20, 2002